

**REMARKS**

**Claims 1 through 6, 8 through 13, 18, and 24 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bogard in view of Shaffer et al.**

In the statement of the rejection the Examiner admitted that the methodology and apparatus disclosed by Bogard differ from those claimed, because Bogard employs a buddy name, such as “Buddy 1” to retrieve a called party’s IM identifier; whereas, in accordance with the claimed invention a telephone number is used to retrieve the IM identifier. The Examiner then turns to Shaffer et al., conspicuously confined to a conference call situation, and concludes that one having ordinary skill in the art would have been motivated to undermine the entire invention of Bogard by ignoring the desired buddy concept and use a shunned telephone number to identify an IM user. The reason offered by the Examiner in the first full paragraph on page 3 of the October 18, 2006 Final Office Action reads as follows:

... in order to simply the process of identifying a called party by using the called party’s telephone number rather than having to remember the called party’s IM username (as though names are more complex than telephone numbers).

This rejection is respectfully traversed. Applicants submit that the Examiner failed to establish the requisite realistic motivation for the proposed combination of references. Indeed, Bogard himself teaches away from the Examiner’s proposed restructuring of his invention, and the Examiner’s proposed modification of Bogard’s invention would, in fact, alter the principle of operation of Bogard’s invention. Applicants respectfully submit that the Examiner attempts to trivialize the difference between a called party’s telephone number and a called party’s username (buddy).

**There is no motivation.**

The motivation necessary to support the obviousness conclusion is not an abstract concept. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). In order to establish the requisite realistic motivation, the Examiner must make clear and particular factual findings as to a specific understanding or specific technological principle and then, based upon such facts, explain **why** one having ordinary skill in the art would have been **realistically** impelled to modify **particular** prior art, in this case the particular method and apparatus disclosed by Bogard, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Generalizations do not suffice. *Ecolochem Inc. v. Southern California Edison, Co.*, *supra*; *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Moreover, the applied prior art must provide not only the factual basis for the requisite motivation, but a reasonable expectation of success. *Velander v. Garner*, 348 F.3d 1359, 68 USPQ2d 1769 (Fed. Cir. 2003); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In applying the above legal tenets to the exigencies of this case, Applicants submit the Examiner failed to establish the requisite realistic motivation. As previously pointed out, the reason offered by the Examiner for modifying the Bogard's system and replacing the "buddy" name with a telephone number is, in the Examiner's words:

... in order to simplify the process of identifying a called party by using the called party's telephone number rather than having to remember the called party's IM username.

Applicants question: **Where in the applied prior art is there a factual basis to support the Examiner's determination that remembering a called party's telephone**

**number is easier than the called party's buddy name?** No such disclosure exists. In this respect the Examiner's attention is invited to *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002), wherein the Court held:

the showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.

The Examiner cannot point out any basis in the applied prior art to support the asserted determination that it is easier to remember a called party's telephone number than the buddy name of a called party. The notion that it is easier to remember a plurality of telephone numbers than a single buddy name defies logic. On the other hand, Applicants submit that there are factual bases to support the conclusion that it is much more difficult to remember telephone numbers than a party's buddy name. This evidence is in Bogard at column 3, lines 54 through 62, wherein it is disclosed that:

Additionally, the user profile provides a useful mechanism for associating telephone identifying information with a single user, or entity. For example, Jane Doe may have a home phone, a work phone, a cell phone, and/or some other telephones. Suitable telephone identifying information for each of those phones can be associated in a single profile for Jane. This allows the system to provide uniformity of customization to a single user, irrespective of where they are calling from.

It is clear from the above evulcation that Bogard's approach provides "a useful mechanism for associating telephone identifying information with a single user, or entry" by providing a buddy name "Jane Doe" in lieu of a home phone number, a work phone number, a cell phone number, and/or some other telephones. How can it be easier to remember a plurality of telephone numbers than a buddy name? That it is easier to remember a buddy name than telephone numbers is also apparent from column 1 of Bogard, lines 54 through 61 which reads as follows:

On the telephone side, several types of "party lines" have been offered, frequently of the pay variety (900 numbers in the United States).

However, these services have never been integrated with an IM service and further these services do not have an “appearance”/”buddy” concept to allow specific users to contact each other. Rather, they are simply large conference calls.

Based upon the foregoing it should be apparent that Bogard’s “buddy” system is designed “... to allow specific users to contact each other.” Specific users are fully aware of “buddy” names.

Applicants, therefore, submit that there is no factual basis in the applied prior art to support the Examiner’s asserted motivation. *Teleflex Inc. v. Ficosa North America Corp., supra*. Rather, there is a clear factual evidence which undermines the Examiner’s reasoning. Accordingly, the Examiner failed to establish the requisite motivational element.

**Bogard teaches away from the claimed invention.**

It is apparent from the above except on column 3 of Bogard, lines 54 through 62, that Bogard’s technique focuses on a “buddy” concept, thereby making it unnecessary to remember plural telephone numbers. This is a **clear teaching away** from the claimed invention. *Ecolochem Inc. v. Southern California Edison, Co., supra; In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). And that is not the only teaching away from the claimed invention.

Specifically, Applicants refer to the above quoted excerpt at column 1 of Bogard, lines 54 through 62, wherein Bogard **distinguishes** the claimed “buddy” concept which allows **specific users** to contact each other vis-à-vis “large conference calls.” Two teachings away from the claimed invention by the primary reference to Bogard should be sufficient to further scotch the Examiner’s announced motivational theory.

**The Examiner's proposed modification of Bogard is antithetic to Bogard's objectives.**

Again, Bogard shuns telephone numbers in favor of a simple "buddy" name. The Examiner's proposed modification would **undo** Bogard's invention by replacing the "buddy" name with a telephone number. That is not what Bogard wants; it is what the Examiner wants in order to reject the claims.

The Examiner's attempt to modify Bogard's "buddy" system is said to be rooted in Shaffer et al. who are confined to **conference calls**. Significantly, in column 1 of Bogard, lines 54 through 61, Bogard **distinguishes** the disclosed "buddy" concept from conference calls. Thus the Examiner would attempt to force feed Bogard with nutritionless matter that Bogard finds indigestible.

Based upon the foregoing it should be apparent that the Examiner's attempt to modify Bogard's "buddy" system in a manner inconsistent with Bogard's disclosed objective is **legally erroneous**. This is because one having ordinary skill in the art cannot be considered realistically motivated to modify an applied reference in a manner inconsistent with the disclosed objectives. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

#### **Evidence of Nonobviousness.**

As previously pointed, out Bogard **teaches away** from the claimed invention by employing a "buddy" name, shunning telephone numbers, and distinguishing over conference calls. This **clear teaching away** from the claimed invention constitutes evidence of

**nonobviousness.** *Ecolchem Inc. v. Southern California Edison, Co.*, *supra*; *In re Bell*, *supra*; *Specialty Composites v. Cabot Corp.*, *supra*; *In re Hedges*, *supra*.

### **Conclusion.**

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed inventions has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the clear teaching away from the claimed invention by the primary reference to Bogard, the conclusion appears inescapable that one having ordinary skill in the art would not have found the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Applicants, therefore, submit that the imposed rejection of claims 1 through 6, 8 through 13, 18, and 24 under 35 U.S.C. § 103 for obviousness predicated upon Bogard in view of Shaffer et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 16, 17, and 19 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bogard in view of Shaffer et al. and Diacakis.**

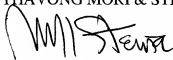
This rejection is traversed. Specifically, claims 16 and 17 depend from independent claim 1, while claim 19 depends from independent claim 18. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 18 under 35 U.S.C. § 103 for obviousness predicated upon Bogard in view of Shaffer et al. The tertiary reference to Diacakis does not cure the previously argued deficiencies in the attempted combination of Bogard and Shaffer et al.

Applicants, therefore, submit that the imposed rejection of claims 16, 17, and 19 under 35 U.S.C. § 103 for obviousness predicated upon Bogard in view of Shaffer et al. and Diacakis is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the arguments submitted *supra*, it should be apparent that the imposed rejections have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9953 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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